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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,350	11/21/2003	Vance M. Smith	4313-031012	3308

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EXAMINER

ELOSHWAY, NIKI MARINA

ART UNIT	PAPER NUMBER
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3781

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/719,350	Applicant(s) SMITH, VANCE M.	
	Examiner Niki M. Eloshway	Art Unit 3781	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 46 and 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-9 and 17-19 is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-16, 46, 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 6, 10-14, 16, 46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koziczkowski et al. (U.S. 5,411,162) in view of DE 195 09 349. Koziczkowski et al. teaches that it is known to provide a coating on a split ring (see coating 92). Koziczkowski et al. does not teach the use of a polymeric coating. DE 195 09 349 teaches that it is known to provide a clamp band with a polymeric coating on the inner surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the container assembly of Koziczkowski et al. with the coating being polymeric instead of metal, as taught by DE 195 09 349, in order to provide a corrosion resistant coating with greater flexibility which can conform easily to irregularities in the inner surface.

Regarding claims 6 and 16, Koziczkowski et al. also does not disclose the thickness of the polymeric coating. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the container assembly of Koziczkowski et al. with the polymeric coating having a thickness between about 15-30 mils, since it has been held that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955), and since a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

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Regarding claim 11, Koziczkowski et al. does not teach a gasket between the cover and container. Kane teaches that it is known to provide a gasket between a cover and container. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified container assembly of Koziczkowski et al. with a gasket between the cover and container, as taught by Kane, in order to better seal the assembly.

3. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koziczkowski et al. (U.S. 5,411,162) in view of DE 195 09 349, as applied to claims 1 and 10 above, and further in view of Dodds (U.S. 5,621,189). The modified container of Koziczkowski et al. discloses the claimed invention except for the polymeric coating being PVC. Dodds teaches that it is known to use PVC as a coating (see col. 6 lines 30-50, where it is disclosed that either polypropylene or PVC may be used). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified container of Koziczkowski et al. with the polypropylene coating being replaced by a PVC coated, as taught by Dodds, in order to give the coating the resistance, resiliency and durability characteristic of PVC.

Allowable Subject Matter

4. Claims 7-9 and 17-19 are allowed.

Response to Arguments

5. Applicant's arguments filed December 22, 2006 have been fully considered but they are not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The metal coating of Koziczkowski et al. is replaced by a

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polymeric coating, therefore the resiliency of the metal coating of Koziczowski et al. is not in question. Regarding the resiliency of the polymeric coating taught by modifying reference DE 195 09 349, it is described in the translated Abstract as “rubbery”. In order for an element to be considered “rubbery”, it must have a fair degree of resiliency. Claim 1 sets forth that “the polymeric coating has a degree of resiliency to absorb impact forces during a drop test” (lines 10-11 of claim 1). It is the examiner’s position that the polymeric coating of DE 195 09 349 meets this limitation to the degree set forth. Due to the resilience and rubbery nature of the polymeric coating of DE 195 09 349, the coating is capable of absorbing a certain amount of force. Since the claims do not set forth the amount of force absorbed, the polymeric coating of DE 195 09 349 meets the limitation to the degree set forth in the claim.

6. In response to Applicant’s arguments regarding the modification of Koziczowski et al. by DE 195 09 349, it is not required that the prior art disclose or suggest the properties newly-discovered by an applicant in order for there to be a prima facie case of obviousness. See *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1905 (Fed. Cir. 1990). Moreover, as long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. See *In re Beattie*, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992); *In re Kronig*, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976) and *In re Wilder*, 429 F.2d 447, 166 USPQ 545 (CCPA 1970). The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F. 2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this regard, a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. *In re Bozek*, 416 F .2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

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7. Replacing the metal coating of Koziczowski et al. with a polymeric coating does not render the modified device unsatisfactory for its intended purpose. The polymeric coating offers a degree of corrosion resistance and offers the additional benefit of conforming to irregularities in the mating surfaces. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).
8. The strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination. In re Sernaker, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983). The advantage of replacing the metal coating with a polymeric coating is that the polymeric coating better conforms to surface irregularities which would provide a better seal between the elements.
9. In response to applicant's argument that the references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references, Koziczowski et al. (U.S. 5,411,162) and DE 195 09 349, are drawn to clamping bands with coatings.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing

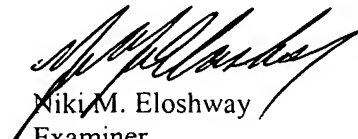
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date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niki M. Eloshway whose telephone number is 571-272-4538. The examiner can normally be reached on Thursdays and Fridays 8 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Niki M. Eloshway
Examiner
Art Unit 3781

nme


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